

Remarks

The Examiner refers to an Amendment of Dec. 29, 1993. However, there was a subsequent Amendment filed on Jan. 14, 1999. A copy of this Amendment, its exhibits, and the return postcard are enclosed for the convenience of the Office. It is not clear whether the Examiner has seen the Jan. 14, 1999 amendment or whether this would change the Office Action. The undersigned has called the Examiner today and left a message in an attempt to clarify the issue. Nevertheless, the following is submitted under the assumption that neither prior two amendments were entered but did not satisfy the Examiner's rejections to the extent continued.

Exhibit 1 to the Jan. 14, 1999 Amendment is a copy of the assignments of the parent application, U. S. Patent 5,122,136, from both of the inventors to The Regents of the University of California as recorded at frame 5257, reel 0574, and frame 5257, reel 0577.

Exhibit 2 to the Jan. 14, 1999 Amendment is a copy of the assignments of the cip of U. S. Patent 5,122,136 from which this application directly continues

from the inventors to their respective employers, namely The Regents of the University of California and Target Therapeutics respectively as recorded at frame 6030, reel 0823 for the former and as recorded at frame 6030, reel 0827, for the latter.

Exhibit 3 to the Jan. 14, 1999 Amendment is a copy of the assignment of the cip parent application from Target Therapeutics to The Regents of the University of California as recorded at frame 0359, reel 8919.

The Examiner objected to the claims under *In Re Schneller*, 158 USPQ 210 (CCPA 1968) on the ground that there is no apparent reason why applicant was prevented from presenting the claims during an earlier application which has matured into an issued patent.

In Re Schneller was an appeal is from a decision of the Patent Office Board of Appeals affirming the examiner's rejection of claims on the ground of double patenting over an issued copending patent to the same applicant. Unlike the present case, there was no terminal disclaimer offered in *In Re Schneller*. The CCPA held that:

"The controlling fact is that patent protection for the clips, fully disclosed in and covered by the claims of the patent, would be extended by allowance of the appealed claims. Under the circumstance of the instant case, wherein we find no valid excuse or mitigating circumstances making it either reasonable or equitable to make an exception, and wherein there is no terminal disclaimer, the rule against "double patenting" must be applied. " 158 USPQ at 214.

The applicant in *In Re Schneller* was attempting to extend the original patent by asserting that the application in question was an independent and distinct invention. This is not the case here, where any extension of U.S. Patent

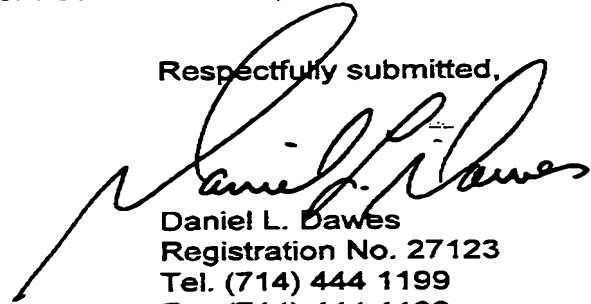
5,122,136 is expressly disclaimed. Thus, *In Re Schneller* is distinguished from the present application.

The cross-reference to all prior applications had been added in the present amendment.

The requested documentary evidence supporting the Terminal Disclaimer and statements in behalf of the assignee under 37 CFR 3.73(b) are included in the Jan. 14, 1999 Amendment.

Nevertheless, enclosed is a fresh Terminal Disclaimer and Statement by Assignee. No additional Terminal Disclaimer Fee is submitted, since this fee has been previously paid in this matter.

Respectfully submitted,



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